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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,105	05/22/2001	Beth Louise Hoffman	ROC920010048US1	9207

7590 01/16/2004

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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,105

Applicant(s)

HOFFMAN ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-6, 10, 12-14, 17-22, 24-27, 29, 33-35 and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Hagan et al. (US 6,595,417).

O'Hagan et al. teach an electronic shopping method and system, comprising:

As per claims 1, 19, 26, 42 and 50,

entering at least one product code (column 3, lines 25-30);

retrieving product location information for at least one product corresponding to the entered at least one product code (column 3, lines 35-40; column 19, lines 5-10);

presenting the retrieved product location information to the customer (column 3, lines 35-40).

As per claims 2, 27 and 29, said method and system, wherein the at least one product code is entered via the Internet (column 6, lines 43-45).

As per claims 3, 10 and 22, said method and system, wherein the at least one product code is entered via a device located at the retail store (column 3, lines 35-40; column 19, lines 5-10; column 28, lines 41-43).

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As per claims 5, 12, 20, 33 and 35, said method and system, wherein the device located at the retail store is a handheld device carried by the customer (column 6, line 65 – column 7, line 1).

As per claims 6, 13 and 21, said method and system, wherein the device located at the retail store is integrated with a shopping container (column 3, lines 31-32).

As per claims 18 and 24, said method and system, wherein the retrieved and presented product location indicates a store aisle in which the at least one product is located (column 28, lines 41-43).

As per claims 25 and 34, said method and system, further comprising means for determining a location of the transportable computing device in the retail store column 12, lines 6-15).

As per claim 51,
selecting a product from an on-line catalog (column 19, lines 29-45; column 21, lines 1-2);
retrieving product location information for the selected product (column 21, lines 1-2);
presenting the retrieved product location information to the customer column 21, lines 1-2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 17 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al.

As per claim 14, O'Hagan et al. teach said method and system, wherein the device located at the retail store is integrated with a shopping container (column 3, lines 31-32).

However, O'Hagan et al. do not specifically teach that said device is integrated with a shopping basket.

Official notice is taken that shopping baskets and shopping containers are commonly used in retail environment.

Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Hagan et al. to include that said device is integrated with a shopping basket, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of O'Hagan et al. would perform the invention as claimed by the applicant with either the shopping container or the shopping basket.

As per claims 17 and 52, O'Hagan et al. teach said method and system, wherein the customer accesses the merchant's web site to browse through general information and create a shopping list, which is then transmitted to the merchant's store (column 19, lines 29-45; column 20, lines 3-9).

However, O'Hagan et al. do not specifically teach that said general information includes store location information.

Official notice is taken that it is well known in e-commerce environment to provide merchant's web pages having merchant's stores location information.

Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Hagan et al. to include that said general information includes store location information, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of O'Hagan et al. would perform the invention as claimed by the applicant with either specifically mentioning the store location information, or not.

Claims 4, 7-9, 11, 15-16, 23, 28, 30-32, 36-37, 38, 40-41, 43-47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. in view of Powell (US 5,887,271).

As per claims 4, 11 and 30-31, O'Hagan et al. teach all the limitations of claims 4, 11 and 30-31, except that said the at least one product code is entered via a kiosk located at the retail store.

Powell teaches a method and system for locating products in a retail system, including a kiosk containing an Internet connected computer, via which product codes are entered (column 5, lines 28-40).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Hagan et al. to include that said store is equipped with

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a kiosk (a computer), because it would provide less expensive product locating system, thereby make it more attractive to small stores.

Also,

As per claims 7, 8, 16, 38, 41, 43-47 and 49, Powell teaches said method and system, wherein the presenting step includes printing the location information on a piece of paper (column 5, lines 37-40; column 13, lines 17-18).

As per claim 9, O'Hagan et al. teach said method and system, wherein the printing occurs at a location remote from the retail store (column 4, lines 30-31).

As per claims 15 and 23, Powell teaches said method and system, wherein the presenting step includes audibly reproducing the retrieved location information (column 5, lines 34-38).

As per claims 28, 32 and 36-37, Powell teaches said method and system, wherein the presentation means includes a printer connected to the personal computer (column 5, lines 37-40; column 13, lines 17-18).

As per claim 40, Powell teaches said method and system, wherein the computer is in wireless communication with the portable computing device (column 6, lines 30-32).

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. and Powell.

As per claim 48, O'Hagan et al. and Powell teach all the limitations of claim 48, except that said printed data includes an indication of an alternative to the unavailable item.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The “uploading” through “presenting” steps would be performed the same regardless of the content of the data printed. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. and Powell in view of Burke et al. (US 6,604,681).

As per claim 39, O'Hagan et al. and Powel teach all the limitations of claim 39, except specifically teaching that said portable computing device is a PDA.

Burke et al. teach an evaluative shopping assistant method and system, wherein the customer's shopping list is accessible from the PDA (column 10, lines 14-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify O'Hagan et al. and Powel to include that said portable computing device is a PDA, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of O'Hagan et al. and Powel would perform the invention as claimed by the applicant with either specifically mentioning that said portable computing device is a PDA, or not.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

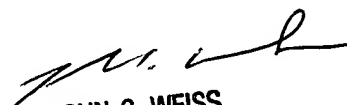
Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB


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